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09/981,251	10/16/2001	Balamani S. Vishwanath	64423-00040	5985

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EXAMINER	
CHEUNG, MARY DA ZHI WANG	
ART UNIT	**PAPER NUMBER**
3621	

DATE MAILED: 02/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary	Application No.	Applicant(s)	
	09/981,251	VISHWANATH ET AL.	
	Examiner	Art Unit	
	Mary Cheung	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 October 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of the Claims

1. This action is in response to the application filed on October 16, 2001. Claims 1-18 are pending.

Claim Objections

2. Claim 9 is objected to because of the following informalities: In line 2 of claim 9, the word "provide" should be deleted. Appropriate correction is required.

3. Claims 8-10 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 8-10 should further limit the system of claim 1, not "an stand-alone application" or "an application".

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 1, it is not clear what "at least one authentication product" and "a security architecture" refer to. Do they refer to software *pro se*? Or do they refer to software and hardware, such as software that embodied in a computer-readable media. For examining purpose, "at least one authentication product" is interpreted as software

pro se because from its dependent claim 7, it appears that "at least one authentication product" does not comprise or embodied in hardware. Furthermore, "a security architecture" is interpreted as software pro se because the word "architecture" can be defined as the design of application software according to Microsoft Press Computer Dictionary Third Edition (1997, ISBN 1-57231-446-X).

Claims 2-18 are rejected for incorporating the errors of their respective base claim by dependency.

Claim 3 recites "the product" in line 1. It is not clear whether "the product" refers to the "software product" in line 1 of claim 1, or the "at least one authentication product" in line 2 of claim 1.

Claim 8 recites the limitation " the authentication architecture " in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. It is not clear that "the authentication architecture" refers to "at least one authentication product" of claim 1, or "a security architecture" of claim 1, or something else.

Claim 9 recites the limitation " the architecture " in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. It is not clear that "the architecture" refers to "a security architecture" of claim 1, or "the authentication architecture" of claim 8, or something else.

6. Claim 3 contains the trademark/trade name Java. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain

since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe product and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to claims 1-18, the claimed system comprises only the software, such as "at least one authentication product", "a security architecture", "a profile application", etc. Although these software are functional descriptive material, the claims are directed to non-statutory subject matter because they are not embodied in computer-readable medium. See MPEP 2106 IV B 1(a).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section

> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-3, 5-6, 8, 10 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Alegre et al., U. S. Patent 6,199,113.

As to claim 1, Alegre teaches a system for user identity management and software product distribution comprising (abstract and column 4 lines 25-42 and Fig. 2):

a) At least one authentication product (column 4 line 25-42 and Figs. 2, 9; *specifically, "at least one authentication product" corresponds to authentication server*);

b) A security architecture capable of protecting the system (Fig. 2);

c) Wherein the at least one authentication product is capable of servicing at least one external source (column 4 lines 40-42 and Fig. 2).

As to claim 2, Alegre teaches a profile application capable of maintaining an online electronic profile for each external source wherein the profile application is accessible by external source system users and end users (column 4 lines 25-42 and column 6 lines 31-33 and Fig. 2; *specifically, the profile application corresponds to user access profile*).

As to claim 3, Alegre teaches the product comprises a series of platform-independent Java based application (column 8 lines 54-65).

As to claim 5, Alegre teaches the security architecture is capable of encrypting of transmitted data for security against spoofing (column 7 lines 32-35).

As to claim 6, Alegre teaches the system is capable of keep tracking of authentication device and ownership/assignments to a plurality of external access sources and their end users (column 6 lines 65-67 and column 8 lines 28-35).

As to claim 8, Alegre teaches a stand-alone application of the system of claim 1 wherein the authentication architecture is capable of providing user authentication and access control as separate functions autonomous from the system of claim 1 (column 5 lines 48-58 and Fig. 5; *specifically, "a stand-alone application" corresponds to the web server as shown in Fig. 5, and "the authentication architecture" corresponds to the structures as shown in Fig. 5*).

As to claim 10, Alegre teaches an application using the system of claim 1, wherein the system is capable of being deployed completely on a client's site, wherein the client comprises a client server, in which the client server is capable of functioning as a server application independent of the system of claim 1 (column 4 lines 25-30 and column 5 lines 8-20, 48-58 and Figs. 2-3, 5; *specifically, "client server" corresponds to the web server as shown in Figs. 2, 5*).

As to claim 18, Alegre teaches the system is capable of managing and tracking specific and group end-user access authorizations to digital content and process for each external source (column 6 lines 65-67 and column 8 lines 28-35 and Fig. 14).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

> invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 4, 9 and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alegre et al., U. S. Patent 6,199,113 in view of Pearce et al., U. S. Patent 6,243,468.

As to claim 4, Alegre teaches the security architecture is capable of automatic encoding of transmitted data (column 7 lines 32-35). Alegre does not specifically teach encoding transmitted data using unique hashing routines. However, Pearce teaches encoding transmitted data using unique hashing routines (column 6 lines 41-47 and Fig. 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the transmitted data in Alegre's teaching to be encoded using unique hashing routines for better protecting the transmitted data from piracy.

As to claim 9, Alegre teaches the stand-alone application, and protecting the transmitted data as discussed above. Alegre does not specifically teach the at least one authentication product and the architecture are capable of providing software piracy

management to software manufacturers distributing application product via CD-ROM or a wide area network. However, Pearce teaches authentication product and security architecture are capable of providing software piracy management to software manufacturers distribution application product via CD-ROM or a wide area network (column 1 line 66 – column 2 line 8 and column 3 line 66 – column 4 line 10, 21-25 and Figs. 1-2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the authentication product and the architecture in Alegre's teaching to include the feature of capable providing software piracy management to software manufacturers distribution application product via CD-ROM or a wide area network for conveniently distributing the transmitted data and better protecting the transmitted data from piracy.

As to claims 11-16, Alegre teaches a system for securely distributing software as discussed above. Alegre does not specifically teach the system is capable of reading CD-ROM content remotely via a wide area network, providing CD media-based copy protection, validating the CD media, providing CD media authentication remotely via a wide area network, providing embedded, encrypted serialization of CD media, providing anti-piracy protection to electronic distributed software, and using CD media developed with anti-piracy technology as effective user authentication devices. However, Pearce teaches this matter (column 1 line 66 – column 2 line 8 and column 3 line 66 – column 4 line 10, 21-26 and column 5 lines 20-45 and column 7 lines 8-40 and Figs. 1-2, 5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the system in Alegre's teaching to include the features of reading CD-

ROM content remotely via a wide area network, providing CD media-based copy protection, validating the CD media, providing CD media authentication remotely via a wide area network, providing embedded, encrypted serialization of CD media, providing anti-piracy protection to electronic distributed software, and using CD media developed with anti-piracy technology as effective user authentication devices because this would allow the distributed software to be conveniently and securely delivered to users, and at meanwhile, it also prevents software piracy.

As to claim 17, Alegre teaches a system for securely distributing software as discussed above. Alegre does not specifically teach the system is capable of bundling full products and license packs on at least one CD-ROM. However, Alegre teaches bundling full products and license packs on a CD-ROM (column 1 line 66 – column 2 line 8 and Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the system in Alegre's teaching to include the feature of bundling full products and license packs on a CD-ROM because this would allow the products and their associated information to be conveniently delivered to users.

14. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alegre et al., U. S. Patent 6,199,113 in view of Reardon, U. S. Patent 6,212,635.

As to claim 7, Alegre teaches the authentication product comprising:

a) A username (column 4 lines 25-40; *specifically, "username" corresponds to user ID*);

b) A password (column 4 lines 25-40);

c) An authentication device (column 4 lines 25-40; *specifically, "authentication device" corresponds to authentication server*);

d) Wherein the authentication device is selected from group consisting of software token (column 4 lines 25-31).

Alegre does not specifically teach the authentication device is selected from group consisting of key chain tokens, and tokens capable being read by a Smart Card Reader. However, this matter is taught by Reardon as an authentication device is selected from group consisting of key chain tokens, and tokens capable being read by a token reader (column 9 lines 54-65 and column 17 lines 36-40 and Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the authentication device in Alegre's teaching to include key chain tokens, and tokens capable being read by a token reader as taught by Reardon for better protecting the authentication product from authorized access.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schneck et al. (U. S. Patent 5,933,498) discloses control access of the distributed data.

Win et al. (U. S. Patent 6,161,139) discloses administrative roles governing access to administrative functions.

Larsson et al. (U. S. Patent 6,226,747) discloses preventing software piracy.

Saito et al. (JP 11355858 A) discloses encrypting distributed information.

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306 (Official Communications; including After Final Communications labeled "BOX AF")

(703) 746-5619 (Draft Communications)

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7th Floor Receptionist.

Mary Cheung
Patent Examiner
Art Unit 3621
February 12, 2004